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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,238	01/31/2004	Ronald L. Darata	03-016-RD	8170
7590	01/19/2005		EXAMINER MAI, HUY KIM	
Lambert & Associates Suite 200 92 State Street Boston, MA 02109			ART UNIT 2873	PAPER NUMBER

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/769,238	Applicant(s) DARATA ET AL.	
	Examiner Huy K. Mai	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-70 and 78-93 is/are allowed.
- 6) ☒ Claim(s) 1-93 is/are rejected.
- 7) ☒ Claim(s) 71-77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement filed on May 18, 2004 is acknowledged.

Oath/Declaration

2. The declaration filed on Jan. 31, 2004 is acceptable.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations "said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed members attached to said vertically disposed member" as claimed in claim 79, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the

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drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 79-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the limitations as claimed in claims 79-91. Nowhere in the specification discloses the limitations "said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed members attached to said vertically disposed member".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8,16-19,26-32,34,46-49,53-56,66,68-70,81-84,87-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The limitations in claim 8 are unclear because of “a rear vertical surface”. A rear vertical surface is not an element of the clip-on assembly, but the auxiliary clip-on lenses defined a vertical surface thereof. The phrase “said single auxiliary clip-on lens” (claims 16-19, line 2) has no antecedent basis. The phrase “the primary spectacle frame assembly” (claims 26-31, line 2 and claim 32, line 3) also has no antecedent basis. The word “substantially” should be added before the word “identical” (claim 26, line 2; claim 27, line 2; and claim 30, line 2) because the auxiliary clip-on assembly is not exactly identical in shape and size to the primary spectacle frame assembly. See the applicant’s Figs.5-8. The phrase “said auxiliary clip-on assembly frame” (claim 34, lines 2-3) has no antecedent basis. The phrase “said outer sides” (claim 46, line 2) should read “said side portions”; otherwise this phrase has no antecedent basis. The phrases “said eyerim” (claim 48, line 2), “said outer side” (claim 47, line 2) and “said projection” (claim 49, line 2) have no antecedent basis. The phrase “said rearwardly concave arcuate shape” (claim 53, line 1; claim 54, line 2; claim 55, line 2 and claim 56, line 2) has no antecedent basis. The phrases “said auxiliary clip-on assembly” (claim 66, lines 6-7) and “the horizontal frame” (claim 66, line 7) have no antecedent basis. The features “a second end piece” (claim 66, line 8) and “the groves” (claim 66, line 9) are undefined. The phrases “attached to” (claim 66, lines 1,4,8) should be expressed in a better word such as “of--”, for example, in order to avoid confusing the steps in the method claims such as “attaching ... to”(claim 66, lines 4,7-8) or “said end piece retainers attach to said eyerims” (claim 68, line 1).

Similarly, the phrase “attached to” (claim 69, lines 1,3) should be expressed in a better word such as “of--”, for example.

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The limitations in claim 70 are indefinite because there is no step to perform the function in the method claim 70. The phrases "said primary spectacle frame" (claim 81, lines 2-3; claim 82, line 3; claim 84, line 3; claim 92, line 4), "said primary frame" (claim 87, line 2; claim 88, line 2) and "said pair" (claim 91, line 1) have no antecedent basis. The phrases "said first and second eyerim" (claim 87, line 2), "said rearmost edge" (claim 89, lines 1,2), "said first and second end piece" (claims 89, lines 2-3; claim 90, lines 2,4), and "the auxiliary spectacle frame" (claim 92, line 9) have no antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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9. Claims 1,2,5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Xiao (6,505,932).

The limitations in claims 1,2,5 are shown in Xiao's Fig.1, columns 3-4. Xiao discloses a primary spectacle frame assembly comprising: an eyerim 151; a first end piece 13 and a second end piece 14 attached to and extending from a first outer side and a second outer side of said eyerim; a first rimblock 17 and a second rimblock 18, a bridge 111 attached to and connecting the inner sides of said eyerim; a first temple 112; and a second temple 113.

10. Claims 8-13,20,23,26,27,30,32 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (5,867,244).

The limitations in claims 8-13,20,23,26,27,30,32 are shown in Martin's Figs. 1-2, columns 2-3. Martin discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses, a rear vertical surface; and a first and second end piece retainers 40,42.

11. Claims 8,15,16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadler (5,416,537).

The limitations in claims 8,15,16 are shown in Sadler's Figs. 1-3, columns 2-3. Sadler discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses 11, a rear vertical surface; and a first and second end piece retainers 17.

12. Claims 33-40,43-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (2001/0021001).

The limitations in claims 33-40,43-65 are shown in Lee's Figs.1,2,6-8, pages 2-3. Lee discloses an eyeglass device comprising: a primary spectacle frame assembly 100 for supporting primary lenses 101 therein, said primary spectacle frame assembly including two side portions each

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having an end piece extended therefrom for pivotally coupling a temple thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions.

13. Claims 33,34,41,42 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang (6,113,234).

The limitations in claims 33,34,41,42 are shown in Huang's Figs.1,2, column 2. Huang discloses an eyeglass device comprising: a primary spectacle frame assembly 10 for supporting primary lenses 23 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple 11 thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions.

Regarding claims 41,42, the frame in the auxiliary frame inherently includes a torsion bar.

14. Claim 71 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lemelson (4,217,037).

The limitations in claim 71 are shown in Lemelson's Figs.1-6, columns 2-4. Lemelson discloses an auxiliary clip-on assembly comprising: a single member lens 41 possessing a front vertical surface and a rear vertical surface; a plurality of end piece retainers 44; and a plurality of fasteners wherein said plurality of end piece retainers 44 are mounted on said rear surface of said single member lens and said fasteners are mounted on said front surface of said single member lens and wherein said fasteners couple said end piece retainers to said lens by penetrating said lens.

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15. Claims 79-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Ifergan (5,614,963).

The limitations in claims 79-91 are shown in Ifergan's Figs. 1-22, columns 2-6. Ifergan discloses an auxiliary clip-on assembly comprising: an auxiliary frame for housing a pair of lenses; a first and a second end piece retainer, said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed members attached to said vertically disposed member.

16. Claims 92,93 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao.

The limitations in claims 92,93 are shown in Xiao's Figs. 1-3, columns 3-4. Xiao discloses an eyeglass device comprising: a primary frame 10 for supporting primary lenses 121,122 therein; the primary frame including two side portions 13,14, a front portion and a rear portion; and the primary frame including a first and a second rimblock 17,18 respectively having a horizontal surface and being secured to one of said side portions of said primary spectacle frame; and an auxiliary frame 20 for supporting auxiliary lenses 201,202 therein and for disposing in front of the primary spectacle frame 10, the auxiliary frame 20 including an auxiliary rear portion, wherein the auxiliary spectacle frame further includes two end piece retainers 22,23 each secured to said auxiliary rear portions and having a horizontal surface for coupling a corresponding horizontal surface of one of said rimblocks so as to secure the auxiliary frame to the primary frame.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3,4,6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao.

Regarding claims 3,4 since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 6,7, the optical properties of the lenses in a pair of spectacles depend on the needs of the user such as prescription lenses or sunglass lenses which are well known and commonly use in this art. Therefore, the limitations in claims 6,7 are unpatentable over Xiao reference.

19. Claims 14,24,25,28,29,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin.

Regarding claims 14,24,25, since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 21,22, absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

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Regarding claims 28,29,31, although Martin device does not teach the shape and size of the auxiliary clip-on assembly being different from those of the primary spectacle frame as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Martin reference by forming an auxiliary clip-on assembly being different from the primary spectacle frame in shape and size. Such a modification would have no functional differences from the Martin reference.

20. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadler.

Absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

21. Claims 66-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

It should be noted that although claims 66-70 "method claims", the method steps consist of the broad steps of "attaching", "applying" and "attaching" and therefore these steps would be inherently satisfied by the apparatus of the reference.

22. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson.

The optical properties of the lenses in a pair of spectacles depend on the needs of the user such as polarized lenses which are well known and commonly use in this art. Therefore, the limitations in claim 78 are unpatentable over Lemelson reference.

Allowable Subject Matter

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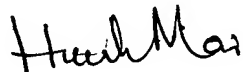
23. Claim 72 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

24. Claims 73-77 are objected to as being dependent upon the above objected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai
Primary Examiner
Art Unit 2873

HKM/
January 13, 2005